

Appl. No. 10/754,380  
Amdt. Dated June 7, 2005  
Reply to Office Action of March 7, 2005

### REMARKS

The present application was filed with 20 original claims. Claims 1-20 have been rejected under 35 U.S.C. §§ 102(a), 102(b) and 103(a) over cited art. Specifically, Claims 14 and 20 stand rejected under 102(b) as anticipated by U.S. Patent No. 2,802,411 to Riener (hereinafter "Riener") and Claims 14-16 and 18 stand rejected under 102(a) as anticipated by U.S. Patent No. 6,450,341 to Krupa (hereinafter "Krupa"). Claims 1-7 stand rejected under 103(a) as unpatentable over U.S. Patent No. 476,340 to Wagandt (hereinafter "Wagandt") in view of U.S. Patent No. 3,724,654 to Gerard et al (hereinafter "Gerard"). Claim 8 has been rejected under 103(a) as unpatentable over Wagandt-Gerard further in view of Riener. Claims 9-12 stand rejected under 103(a) as unpatentable over U.S. Patent No. 6,745,660 to Caputo (hereinafter "Caputo") in view of Gerard. Claim 13 has been rejected under 103(a) as unpatentable over Caputo-Gerard further in view of U.S. Patent No. 4,452,419 to Saleeba (hereinafter "Saleeba").

Claim 20 has been objected to under 35 U.S.C. 112, second paragraph, as indefinite. Claims 17 and 19 have been objected to as depending from a rejected base claim, but have been indicated as allowable if rewritten in independent form.

The remarks below address the current 102 and 103 rejections and the 112 objections. Reconsideration of all pending claims is now respectfully requested.

#### § 112 Objection

Claim 20 has been amended to correct an inadvertent error in assigning claim dependency. Claim 1 has been amended to delete an extra "the" in the eighth line. The

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amendments are well-supported throughout the specification and, therefore, no new matter has been added.

#### § 102 Rejections

In order for a reference to act as a §102 bar to patentability, the reference must teach each and every element of the claimed invention. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771 (Fed. Cir. 1983). Without the required teaching of "each and every element" as set forth in the claims, it is improper for the Examiner to continue such rejections under §102(b).

Claims 14 and 20 have been rejected as anticipated by Riener. Applicants respectfully traverse this rejection and requests reconsideration of all claims.

Claim 14 is an independent claim under consideration, with Claim 20 dependent therefrom. Claim 14 has been amended to clarify a detail of the indicia of the base wall which distinguishes over the cited art.

Claim 14, as amended, is directed to a cooking utensil and requires each of the following elements:

- a base wall having a flat planar upper surface;
- a plurality of evenly spaced non-raised first indicia; and
- a plurality of evenly spaced non-raised second indicia.

The present application discloses forming indicia on the peripheral flange by embossing the lower surface of the flange to produce a raised surface. However, with respect to indicia placed on the base wall, the specification states:

"... the indicia 21 and 26-28 may be formed by embossing the upper surface 11a of the bottom wall 11, so that the embossments may slightly deform the bottom surface of the bottom wall 11. It

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will be appreciated that the indicia could also be formed by etching or the like or by other suitable surface marking techniques.”

Clearly, a concern with placing indicia on the base wall is to do so without inhibiting the removal of food items by having raised indicia. Another aspect of having indicia on the base wall is to allow proper portioning and placement of food items to be baked, such as, for example, cookies.

Riener discloses a pie plate having a series of long ribs 12 and a series of short ribs 13. According to the disclosure of Riener, “the ribs 12 and 13 upstand from the top surface 11....” (Col. 3, lines 26-29). The purpose of the long and short ribs of Riener is to form very small passages beneath the crust to permit the escape of moisture trapped between the pie crust and the body M of the pan (col. 4, lines 11-17).

Riener fails to teach each and every element of the claimed invention. Riener requires the use of raised ribs on the bottom surface of the pan to allow moisture to escape. Further, the ribs of Riener do not assist in the placement or portioning of food items. That is, there is no teaching of the ribs 12, 13 being used as indicia. Accordingly, Riener neither anticipates or renders obvious the invention as set forth in Claims 14 and 20 of the present application.

Claims 14-16 and 18 have been rejected as anticipated by Krupa. Applicants respectfully traverse this rejection and requests reconsideration.

Claim 14 is an independent claim under consideration, with Claims 15, 16 and 18 dependent therefrom. As discussed previously, Claim 14 has been amended to clarify a detail of the indicia of the base wall which distinguishes over the cited art.

Claim 14 requires the first indicia and the second indicia to be “disposed on the upper surface” of the base wall. Krupa does not disclose indicia on the upper surface of the base wall,

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but rather Krupa discloses holes in the base wall itself. While embossing displaces the upper surface to create indicia on the surface, the actual surface of the cooking utensil remains. On the other hand, holes placed in the base wall remove the upper and lower surfaces entirely. The loss of cooking surface area is an undesired effect. The are not "on" the supper surface, rather they are through the base wall. There is no upper surface at the hole for the hole to be on.

Krupa discloses the purpose of the larger holes 28 to hold baking cups for food items such as cupcakes and muffins. The small holes 26 are air holes to provide air circulation and heat transfer during freezing and baking operations (col. 3, lines 1-6). Neither set of holes is disclosed for use as indicia. Further, while the air holes 26 are spaced equidistantly apart, they are neither for placement or portioning of food items.

Accordingly, Krupa fails to teach each and every element of the claimed invention. Krupa discloses the use of holes through the cooking utensil rather than indicia on the bottom surface of the pan. Further, the holes of Krupa do not assist in the placement or portioning of food items. That is, there is no teaching of the holes 26, 28 being used as indicia. Accordingly, Krupa neither anticipates or renders obvious the invention as set forth in Claims 14-16 and 18 of the present application.

Applicants respectfully request reconsideration of the 102 rejections in light of the amendments herein and the remarks set forth above.

#### § 103 Rejections

Claims 1-7 have been rejected under 103(a) as unpatentable over Wagandt in view of Gerard. Applicants traverse this rejection and respectfully request reconsideration of the pending claims.

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Claim 1 is an independent claim, while claims 2-7 are dependent therefrom. Claim 1 requires, *inter alia*:

A set of indicia disposed on the peripheral flange including plural first indicia and plural second indicia.

Wagandt is directed to a circular baking plate for pies. The surface of the plate is embossed with ribs 5 extending across the base wall, up the side wall and onto the flange. The ribs allow the plate to be held above the oven bottom to prevent burning and also to guide cutting of the pie into equal pieces for serving.

Gerard is directed to a cup tray and container to be used as "a particle counter sample cup and tray assembly employed during various sample collecting and analyzing procedures in the medical and scientific fields." (Col. 2, lines 20-26).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action points to no teaching or suggestion within Wagandt or Gerard which would lead one skilled in the art to combine these unrelated fields of pie plates and medical sample trays. The examiner's example of the storied "baby in the King's Cake," while making

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for an interesting internet research project to determine its meaning, is a far too strained and peculiar illustration to be regarded as a credible teaching or suggestion by the cited references. In fact, neither of the cited references makes any mention of using either disclosed invention for preparation of a King's Cake.<sup>1</sup> Nor does either reference disclose the very unusual need to locate items retained within baked goods.

Accordingly, Applicants consider the combination of the Wagandt and Gerard references to be without merit. Reconsideration and withdrawal of the 103 rejection is respectfully requested.

Claims 9-12 have been rejected under 103(a) over Caputo in view of Gerard. Claim 9 is an independent claim from which Claims 10-12 depend. Applicants respectfully traverse this rejection and request reconsideration.

Claim 9 requires the following elements:

- plural first indicia disposed on the flange;
- plural second indicia disposed on the flange;
- each first and second indicium being disposed opposite a corresponding first and second indicium.

Caputo is directed to an apparatus for cutting baked goods and comprises a cake pan having a plurality of spaced guide pins and a straightedge having a longitudinal slot. The straightedge, via the longitudinal slot, is placed over a pair of guide pins and used to guide a knife in cutting the food item in the cake pan.

<sup>1</sup> The King's Cake appears to be either a bread or a pastry rather than a traditional cake or pie. See [http://www.mardigrasunmasked.com/mardigras/king\\_cake.htm](http://www.mardigrasunmasked.com/mardigras/king_cake.htm).

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As discussed previously, Gerard is directed to a sample tray for use in the medical and scientific fields. For all the reasons above, the combination of Caputo and Gerard must also fail. The field of baking utensils is non-analogous to the field of sample trays, and those skilled in one would not look to the teachings of the other to solve problems of the particular art. Specifically, the need for indicia on bakeware to provide cutting and spacing guides and for portion sizing, is unrelated to the use of indicia on a medical sample tray to track unused samples.

Applicants contend that Claims 1, 9 and 14, as amended, distinguish over the cited references and are, therefore, allowable. As the remaining claims depend from one of either independent Claims 1, 9 or 14, merely adding further limitations to the base claim, such claims also should be considered to distinguish over the disclosures of the various cited references.

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### CONCLUSION

Claims 1-20 are currently pending in the present application. The current Office Action has rejected claims under 35 U.S.C. 102 and 103, and has objected to other claims under 35 U.S.C. 112. Claims 1 and 20 have been amended to correct inadvertent typographical errors. Claim 14 has been amended to clarify an aspect of the claimed surface indicia. All remaining claims, as originally filed, are considered to distinguish over the cited art. The arguments set forth in the Remarks section above clearly point out how Claims 1-20 distinguish over the cited references. Accordingly, Applicants believe all claims are now in condition for allowance. Notice to that effect is respectfully requested at the examiner's earliest convenience.

Respectfully submitted,

By 

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